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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,980	04/25/2000	Shigenori Morikawa	00296/LH	9027

7590 03/04/2004

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/557,980

Applicant(s)

MORIKAWA ET AL.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-15 have been examined.

#### ***Priority***

2. The instant application claims priority to Japan Patent Application No. 11-121200, filed 28 April 1999 and Japan Patent Application No. 11-266853, filed 21 September 1999.

#### ***Information Disclosure Statement***

3. The following Information Disclosure Statement in the instant application has been fully considered:

Paper No. 3, filed 4 September 2003.

#### ***Claim Objections***

4. Claim 1 is objected to because of the following informality: in the preamble, the claim teaches to the storing of data in a potable recording medium. It is being presumed that this actually refers to a *portable* recording medium.

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5. Claims 10 and 14 are objected to because of the following informalities: each claim lacks a transitional phrase. In each claim, it is being presumed that all phrases after the word "wherein" are open-ended limitations.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is unclear whether the phrase "wherein in a case of ... said portable terminal apparatuses" is meant to be a limitation. It is being presumed that it is.

Regarding claim 3, it is unclear whether the phrase "wherein in a case where ... software and data" is meant to be a limitation. It is being presumed that it is.

Regarding claim 6, it is unclear whether the phrase "wherein at a time ... said recording medium" is meant to be a limitation. It is being presumed that it is.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,778,072 to Samar.

As per claims 1, 7, 8, and 12, the smartcard-based access system disclosed by Samar reads authentication information from the token to a portable remote processor (such as a personal computer), and determines access based upon the information (see column 4, lines 28-37 and column 5, line 66 to column 6, line 24). Applications can be accessed directly from the portable system (see column 4, lines 61-65 and column 5, lines 19-22).

As per claims 2 and 13, the smart card may contain multiple keys, and be associated with users and/or groups (see column 6, lines 25-35).

As per claim 3, file access may be dependent upon a user's permission level (see column 3, line 63 to column 4, line 7).

As per claims 4-6, smartcard information is stored for the length of a session (see column 3, lines 16-21 and 46-52).

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As per claims 9 and 10, the system may be used for database access (see column 5, line 19-46).

As per claims 11, 14, and 15 the portable terminal can access and decrypt database files (see column 5, lines 19-46).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S Patent No. 3,956,615 to Anderson et al. discloses an encrypted transaction system using access cards.

U.S. Patent No. 5,225,664 to Iijima discloses a mutual authentication system using smartcards having multiple keys.

U.S. Patent 5,509,073 to Monnin discloses the broadcasting to groups of users having smartcards.

U.S. Patent No. 5,544,246 to Mandelbaum et al. discloses a smartcard containing id codes for several computer service providers.

U.S. Patent No. 5,771,291 to Newton et al. discloses a system for user identification using very long id keys on a smartcard.

U.S. Patent No. 5,784,464 to Akiyama et al. discloses a key access system for portable modules.

U.S. Patent No. 5,875,480 to LeRoux et al. discloses the use of large capacity smart-cards.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 4:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**


(703) 872-9306  
Hand-delivered responses should be brought to Crystal Park 2, 2121  
Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MEH



March 1, 2004



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100